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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,605	06/01/2001	Akihiro Teramachi	010713	8594
38834	7590	05/12/2006	EXAMINER	
WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036			CHOI, PETER H	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 05/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/871,605		TERAMACHI, AKIHIRO	
	Examiner		Art Unit	
	Peter Choi		3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7 and 9-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7 and 9-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 28, 2006 has been entered. Applicant has amended claims 1, and 7. Claims 1, 3-7, and 9-12 are pending in the application.

Response to Arguments

2. Applicant's arguments with respect to claims 1 and 7 have been considered but are moot in view of the new ground(s) of rejection as necessitated by amendment.

3. As stated in the previous Office Action mailed November 29, 2005, the Applicant did not challenge the Official Notice cited in the Office Action mailed June 15, 2005. Those statements have been admitted as prior art.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 3-7 and 9-12 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are:

Applicant has amended claims 1 and 7 to include a limitation that an “operator” selects members to request engineering information.

However, it is unclear whether said “operator” is a computerized logic module, or a person. An operator can be a logical operator (such as computer logic that automatically performs a function) or a person who operates a machine or device (i.e., a user operating a computer would be an “operator”).

The specification implies that the operator is a person (see lines 11-13 of page 10 of the specification). Specifically, the limitation states that an “operator” is: “a business operator who desires to gather engineering information by means of the present system”. The definition set forth in the specification suggests that users of the system are the “operator” of the claimed invention. The claim language further supports this, in that it provides a limitation for applicants “to report predetermined items from a network terminal operated by the applicant”, thus implying that said applicant is an “operator” of the network terminal and claimed invention.

It is unclear if the claimed “operator” is a title for the user of the claimed invention, or if there is an additional intermediary party that facilitates an exchange of information and knowledge between parties. For example, if a user searching for an auto mechanic provides information on the make and model of their car, along with a question regarding maintenance, an intermediary party may monitor the communications network and parse through the membership database in order to select a member whose expertise is in the subject area raised by the user’s question and would be able to answer said user’s question. In this instance, the intermediary would be the “operator”.

The claim language also provides a limitation of “performing examination operation” on reported information, which implies that the interaction from the user (applicant) facilitates a series of logic modules to be executed in order to register membership solicitation information and qualify said user (applicant) for membership. Thus, it is unclear if the “operator” is a computer logic module that identifies suitable members from a membership database to request information from.

For purposes of examination, the Examiner has interpreted the newly amended limitation of the “operator” to be a logic module. Clarification is required to resolve the conflicting implications of the “operator” limitation.

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Claims 2-6 and 9-12 are dependent on claims 1 and 7 and are rejected under the same rationale.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 3-7, and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eisenhart (PGPub 2001/0047276) in view of Dworkin et al. (U.S. Patent #6,026,148).

As per claim 1, Eisenhart teaches an open research and development method comprising the steps of:

sending membership solicitation information (**registration data**) to a communications network (**using Internet 100**) from a predetermined server (**at a web-based presentation interface on a pedestrian web site**) [Paragraphs 12 and 31];

causing an applicant for membership to report predetermined items (**registration data including company contact information, personal contact information, role performed, requested login account, company affiliation, electronic mail address**)

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from a network terminal (**computer**) operated by the applicant, by way of the communications network (**using Internet 100**) [Paragraphs 12 and 105];

performing examination operation (**verification of qualifications**) on the reported information (**registration data, contact information**) in connection with membership registration [Paragraphs 12, 45 and 105];

registering the (**identification**) information about the applicant into a membership database (**database 340**) (**as a member or personal profile**) on at least the condition that the applicant should have passed the examination operation (**user is a member**) [Paragraphs 13, 45, 46]; and

accumulating, into a knowledge database (**collection of resources {editorial content, templates, tools, links, discussion forums, etc.}** into a digital library) , information which has been transmitted from members (**technology asset 226, technology project 228, and confidential data such as technical documents, test results, and empirical studies**) registered in the membership database by way of the communications network in relation to a specific topic (**organized by topic, type of deal sought, targeted industry segment**) [Paragraphs 33, 52, 54].

Eisenhart teaches the steps of compiling a list of members by utilization of information about the members (**member profile and need profile of member**) registered in the membership database [Paragraphs 14 and 55] and teaches the step of transmitting engineering information by means of a communications network (**Supplier server 222 connects to Internet 100 and provides access to technology asset 226,**

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technology project 228, and confidential data such as technical documents, test results, and empirical studies) [Paragraph 33], but does not explicitly teach the step of using an operator to select members and to request engineering information from said selected members.

However, Dworkin et al. allows for an expert respondent to be selected manually by the user or automatically by the system [Column 2, lines 7-9].

Dworkin et al. enables the user to be given the opportunity to direct a question to an expert of his or her choice. The system could ask the user to indicate a subject, from a menu of possible subjects, and the system would then choose an expert according to the subject selected [Column 7, lines 19-22].

Alternatively, the system taught by Dworkin et al. can also be programmed to direct the question to a particular expert respondent. The key words appearing in a question may be analyzed and compared with the key words appearing in a biography of the expert [Column 7, lines 11-19].

Since the user specifies a subject that has a plurality of members that are experts in said subject, said user (or “operator”, as per the Applicant’s definition of “operator” in the specification) has thereby selected members to request information

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from. Therefore, both the computer logic and the user ("operator") of the Dworkin et al. invention select members from which to request information.

Both Eisenhart and Dworkin et al. are directed towards the electronic exchange of expert information; therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Eisenhart to include the ability to select members to request information from based on membership information about each expert, because the resulting combination would facilitate the pairing of said user with an expert able to answer said user's question based on said expert's membership information and areas of expertise more efficiently.

Furthermore, the "engineering" information recited in claim 1 is only found in the non-functional descriptive material and is not functionally involved in the steps recited nor does it alter the recited structural elements. The recited method steps would be performed the same regardless of the type of data exchanged. Further, the structural elements remain the same regardless of the type of data exchanged. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.

As per claim 3, Eisenhart teaches the open research and development method according to claim 1, further comprising the steps of:

submitting given inquiries to the applicant (**request for registration data**) by way of the communications network (**Internet 100**) [Paragraphs 12 and 31]; and determining whether to register the applicant as a member (**qualifying the potential member**), on the basis of answers provided (**registration data and contact information**) in response to the inquiries [Paragraphs 12 and 45].

As per claim 4, Eisenhart teaches the open research and development method according to claim 1 or claim 3, wherein the items to be reported by the applicant include items to be used for grasping the applicant's experience (**personal work history**) in research and development [Paragraph 13].

As per claim 5, Eisenhart teaches the open research and development method according to claim 1, further comprising the steps of:

concluding a secrecy memorandum (**exclusive review agreement and nondisclosure agreement**) with the applicant who has passed the examination operation (**member**) [Paragraphs 15 and 90]

Eisenhart teaches a digital notarization of key documents (such as exclusive review agreements). Official Notice is taken that it is old and well known in the art that digital copies of documents (such as digitally notarized documents) can be transmitted between users through means that are also old and well known in the art (Internet, electronic mail, file transfer protocol, etc.). Therefore, it would have been obvious to one

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of ordinary skill in the art at the time of invention to modify the teachings of Eisenhart to include the step of using the Internet to conclude a secrecy memorandum between users as a efficient, low-cost means of ensuring that both parties have received certified notarized copies of the exclusive review agreement.

Eisenhart does not explicitly teach the step of admitting membership registration of the applicant only if the applicant has concluded the secrecy memorandum. However, Eisenhart teaches a system where registered users are required to conduct an exclusive review agreement with potential members whom they wish to collaborate with before an exchange of information can occur. Only when an agreement of collaboration is made and notarized can either party access a secure collaboration area in a project portal [Paragraphs 47 and 86]. Members who do not have such agreements in place are only permitted to view non-sensitive information, such as member profiles, need profiles of users, and a catalog of technology innovations available for exchange. Members who have agreed to the exclusive review agreements are enabled to view and exchange sensitive information, whereas members without such agreements are only able to view non-sensitive information, accomplishing the same task as only allowing membership to users agreeing to non-disclosure agreements, meeting the limitation of the claim.

As per claim 6, Eisenhart teaches the open research and development method according to claim 1, wherein the communications network corresponds to the Internet (**Internet 100**), and the membership solicitation information (**registration data**) is sent

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from a WWW server via the Internet (**community web site 320 using Internet 100**)

[Paragraphs 12, 31 and 42].

As per claim 7, Eisenhart teaches an open research and development system comprising:

means (**Internet 100, mail server 301, pedestrian website 310, and private mail server 350**) for sending membership solicitation information (**registration data**) to a communications network (**through the pedestrian web site**) [Paragraphs 12, 31, 38 and 41];

means (**Internet 100, mail server 301, pedestrian website 310 and private mail server 350**) for sending items (**registration data including company contact information, personal contact information, role performed, requested login account, company affiliation, electronic mail address**) to be reported at time of application for membership to a network terminal (**computer**) operated by an applicant, by way of the communications network (**Internet 100**) [Paragraphs 12, 38, 41, and 105];

means for acquiring the items (**registration component 321 receives registration and identification data**) which are transmitted from the network terminal by way of the communications network (**Internet 100**) and for performing an examination (**verification of qualifications by qualification component 322**) in connection with membership registration on the basis of the received information (**registration data, contact information**) [Paragraphs 12, 45 and 105];

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means for registering (**registration component 321**) the (**identification**) information about the applicant into a membership database (**database 340**) (**as a member or personal profile**) at least on condition that the applicant has passed the examination (**user is a member**) [Paragraphs 13, 45, 46]; and

means (**Collaboration Manager 325 containing Directory browsing component 430 and Custom feed component 410**) for accumulating, into knowledge database (**collection of resources {editorial content, templates, tools, links, discussion forums, etc.} into a digital library**), information which pertains to a certain topic (**organized by topic, type of deal sought, targeted industry segment**) and which has been sent from a member registered in the membership database (**member with member profile listed**) by way of the communications network (**Internet 100**).

[Paragraphs 51-52,54-55]

Eisenhart teaches the steps of compiling a list of members by utilization of information about the members (**member profile and need profile of member**) registered in the membership database [Paragraphs 14 and 55] and teaches the step of transmitting engineering information by means of a communications network (**Supplier server 222 connects to Internet 100 and provides access to technology asset 226, technology project 228, and confidential data such as technical documents, test results, and empirical studies**) [Paragraph 33], but does not explicitly teach the step of using an operator to select members and to request engineering information from said selected members.

However, Dworkin et al. allows for an expert respondent to be selected manually by the user or automatically by the system [Column 2, lines 7-9].

Dworkin et al. enables the user to be given the opportunity to direct a question to an expert of his or her choice. The system could ask the user to indicate a subject, from a menu of possible subjects, and the system would then choose an expert according to the subject selected [Column 7, lines 19-22].

Alternatively, the system taught by Dworkin et al. can also be programmed to direct the question to a particular expert respondent. The key words appearing in a question may be analyzed and compared with the key words appearing in a biography of the expert [Column 7, lines 11-19].

Since the user specifies a subject that has a plurality of members that are experts in said subject, said user (or "operator", as per the Applicant's definition of "operator" in the specification) has thereby selected members to request information from. Therefore, both the computer logic and the user ("operator") of the Dworkin et al. invention select members from which to request information.

Both Eisenhart and Dworkin et al. are directed towards the electronic exchange of expert information; therefore, it would have been obvious to one of ordinary skill in

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the art at the time of invention to modify the teachings of Eisenhart to include the ability to select members to request information from based on membership information about each expert, because the resulting combination would facilitate the pairing of said user with an expert able to answer said user's question based on said expert's membership information and areas of expertise.

Furthermore, the "engineering" information recited in claim 1 is only found in the non-functional descriptive material and is not functionally involved in the steps recited nor does it alter the recited structural elements. The recited method steps would be performed the same regardless of the type of data exchanged. Further, the structural elements remain the same regardless of the type of data exchanged. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); MPEP 2106.

As per claim 9, Eisenhart teaches the open research and development system according to claim 7, wherein the means for sending items (**Internet 100, mail server 301, pedestrian website 310, and private mail server 350**) to be reported at the time of application for membership submits given inquiries (**request for registration data**) to the applicant by way of the communications network (**Internet 100**) [Paragraphs 12 and 31, 38 and 41]; and the means for performing an examination (**verification of qualifications by qualification component 322**) performs an examination (**qualifying**

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the potential member) on the basis of answers provided **(registration data and contact information)** in response to the inquiries [Paragraphs 12, 45 and 105].

As per claim 10, Eisenhart teaches the open research and development system according to claim 7, wherein the items to be reported for application by the applicant includes items to be used for grasping the applicant's experience **(personal work history)** in research and development [Paragraph 13].

As per claim 11, Eisenhart teaches the open research and development system according to claim 7, further comprising:

means **(Secure collaboration manager 331 and Contract manager 530)** for submitting a secrecy memorandum **(exclusive review agreement and nondisclosure agreement)** to the applicant who has passed the examination operation **(member)**, by way of the communications network [Paragraphs 15, 84 and 90]; and

means **(Deal tracker component 450, which contains acceptance component 458)** for determining whether or not the involved parties have agreed on the secrecy memorandum **(when a supplier and either a buyer or contributor reach an agreement during the course of the negotiation of a notarized document of an exclusive review agreement)** on the basis of the information transmitted from the network terminal in response to the submitted secrecy memorandum [Paragraphs 63, 83-86] .

Eisenhart teaches a digital notarization of key documents (such as exclusive review agreements). Official Notice is taken that it is old and well known in the art that digital copies of documents (such as digitally notarized documents) can be transmitted between users through means that are also old and well known in the art (Internet, electronic mail, file transfer protocol, etc.). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the teachings of Eisenhart to include the step of using the Internet to conclude a secrecy memorandum between users as a efficient, low-cost means of ensuring that both parties have received certified notarized copies of the exclusive review agreement.

As cited above, Eisenhart does not explicitly teach the step of admitting membership registration of the applicant only if the applicant has concluded the secrecy memorandum. However, Eisenhart teaches a system where registered users are required to conduct an exclusive review agreement with potential members whom they wish to collaborate with before an exchange of information can occur. Only when an agreement of collaboration is made and notarized can either party access a secure collaboration area in a project portal [Paragraphs 47 and 86]. Members who do not have such agreements in place are only permitted to view non-sensitive information, such as member profiles, need profiles of users, and a catalog of technology innovations available for exchange. Members who have agreed to the exclusive review agreements are enabled to view and exchange sensitive information, whereas members without such agreements are only able to view non-sensitive information, accomplishing the

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same task as only allowing membership to users agreeing to non-disclosure agreements, meeting the limitation of the claim.

As per claim 12, Eisenhart teaches the open research and development system according to claim 7, wherein the communications network corresponds to the Internet (**Internet 100**), and the membership solicitation information (**registration data**) is sent from a WWW server via the Internet (**community web site 320 using Internet 100**) [Paragraphs 12, 31 and 42].

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Mears et al. (U.S Patent #6,438,580) teaches an interactive knowledgebase system that comprises a server and a client.

Linetsky et al. (U.S Patent #6,434,549) teaches a network-based, human mediated exchange of information provided in response to receipt of an information query.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Choi whose telephone number is (571) 272 6971. The examiner can normally be reached on M-F 8-5.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PC

May 9, 2006

Peter Choi
Examiner
Art Unit 3623


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